

REMARKS

Claims 11-28 are pending, while claims 22 and 28 are withdrawn from consideration. Claims 11-21 and 23-27 stand rejected. Applicants have requested Continued Examination, so that the finality of the rejection is removed. Applicants have cancelled claims 22 and 28. Upon entry of the amendments, claims 11-21 and 23-37 remain pending.

Applicants offer a Declaration by one of the inventors in support of the patentability of their claims, in light of the following discussion. Applicants respectfully request that the obviousness rejection of the claims in view of the Lutkus reference and the Whitford Paper be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 11-21 and 23-27 are rejected as obvious over the Lutkus reference (U.S. Patent No. 6,224,311) in view of the Whitford Paper. For the reasons discussed in previous prosecution and as further illustrated and developed in the attached inventor's 2007 Declaration, Applicants respectfully traverse the rejection and request reconsideration.

A prima facie of the obviousness of claims can be rebutted if an Applicant presents objective evidence of unexpected results. When such evidence is presented, the rejection must be reconsidered. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence.

In previous prosecution, Applicants have argued the claims are patentable over their earlier work ("the Lutkus reference"), because even though a prima facie case of obviousness is made out in light of that work and the Whitford Papers cited by the Examiner, nevertheless the invention provides unexpected benefits that are sufficient to rebut the prima facie case of

obviousness. In particular, the Applicants have argued that the superiority of the currently claimed inserts in the prevailing torque test is a surprising result that supports their patentability.

In August 2006 Applicants offered a first Lutkus Declaration reporting the observation that the currently claimed inserts (with a chromate free coating) perform better than chromate coated inserts in a prevailing torque test. The specification points out that this better performance is especially seen using tangless inserts. The Declaration provided data on tanged inserts and offered the inventor's observation that a) even the subtle differences shown in the tanged data was significant and b) although there was no data, the differences with tangless inserts was even more noticeable.

August 2007 Declaration of William J. Lutkus

The 2007 Declaration presents further data on the comparison of the performance of chromium free versus chromium-containing inserts. The data were generated on 5 common sizes of tangless inserts, one set of which was coated with a chromium-containing PTFE coating (the prior art), while the other was coated with the coatings of the current invention, being chromium free.

As described by Mr. Lutkus, his experimental data show a clear difference between the chromate and non-chromate inserts. All of the systems tested show significantly higher torque with the prior art coatings. Three of the sizes tested with the prior art coating actually fail the torque test, while the other two give results in the upper range of acceptable values.

The data presented in the attached Declaration show that there are significant and unexpected differences between inserts coated with the prior art coatings and those coated with the coatings of the current claims. Such a showing of unexpected results is consistent with Applicants' description of their invention and with the scope of the current claims.

Based on the showing of unexpected results in the attached 2007 Declaration, Applicants respectfully request the prima facie case of obviousness be withdrawn.

CONCLUSION

For the reasons discussed above, Applicants believe that claims 11-21 and 23-27 are in an allowable condition and respectfully request an early Notice of Allowance. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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By: Mark A. Frentrup
Robert M. Siminski,
Reg. No. 36,007
Mark A. Frentrup
Reg. No. 41,026

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

RMS/MAF/cg/jao